

REMARKS

Pursuant to the present amendment, claims 1, 14, 22, 24, 26 and 29 have been amended, claims 9, 10, 16, 20, 21, 23 and 31 have been canceled, and new claims 32-36 have been added. Thus, claims 1-8, 11-15, 17-19, 22, 24-30 and 32-36 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested.

As an initial matter, claims 9, 10, 23, and 24 were indicated to be allowable if presented in independent form. Pursuant to the present amendment, new claims 32 and 33 have been added to re-present dependent claims 9 and 10, respectively, in independent form. Thus, new claims 32-33 are in condition for immediate allowance.

Additionally, independent claim 22 has been amended to include the limitations from now-canceled dependent claim 23. Thus, it is respectfully submitted that claims 22 and 24-28 are in condition for immediate allowance.

In the Office Action, claims 1-5, 11-22, 14-19 and 29 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Munk '182 (U.S. Patent No. 6,746,182). Claims 1-8, 11-22, 25 and 28-31 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Munk '336 (U.S. Patent Publication No. 2002/0009336). Applicants respectfully traverse the Examiner's rejections.

As the Examiner well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency requires that the asserted proposition necessarily flow from the disclosure. *In re Oelrich*, 212

U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Oelrich*, at 326, quoting *Hansgirk v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Skinner*, at 1789, citing *Oelrich*. Where anticipation is found through inherency, the Office’s burden of establishing *prima facie* anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Skinner* at 1789.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35

U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

Applying these legal standards, it is respectfully submitted that all pending claims are in condition for immediate allowance. Pursuant to the present amendment, independent claim 1 has been amended to recite that the bushing is releasably coupled to the keel joint. It is respectfully submitted that claim 1, and all claims depending therefrom, are allowable over the prior art of record.

Munk '182 is understood to be directed to a keel joint assembly that permits a degree of rotational movement of a riser within a keel. It is unclear from the Office Action exactly which embodiment disclosed in Munk '182 the Examiner relied on in making the present rejection. In

the embodiment depicted in Figure 3, a stiff can 32 is positioned around the riser 14. A plurality of supports 34 are securely affixed to the hull 22. The supports 34 have rounded, non-puncturing ends that engage the can 32. The embodiment depicted in Figure 4 employs a centralizer assembly secured within the hull 22. The centralizer 72 may comprise hydraulically actuated piston-type assemblies, or two arms 72a, 72b that are hingedly affixed to one another at hinge point 72. The centralizers 72 have rounded, non-puncturing tips 74 that bear on the riser 14.

The embodiment depicted in Figure 5 of Munk '182 comprises a riser collar 92 that surrounds a portion of the riser 14 proximate the keel 26. "The collar 92 is not affixed to the riser but instead permits sliding movement of the riser 14 upwardly and downwardly." Col. 4, ll. 46-48 (emphasis added). The collar 92 includes a bulbous portion 94 that is adapted to be positioned within a rounded profile 102 of a guide sleeve 100. To assembly the keel joint, the collar 92 and guide sleeve 100 are assembled onto the riser 14. The riser 14 is then run through the passage 24' and the landing profile 104 of the guide sleeve 100 is seated into the matching profile 102 in the keel 26. In operation, the riser can slide upwardly and downwardly within the collar 92 as necessary to compensate for movement of the floating platform. The system also accommodates some degree of rotational movement due to the bulbous portion 94 positioned within the rounded profile 102.

Munk '336 is understood to be directed to a fixed connection between a riser and a receptacle of a floating platform that may be preloaded to reduce fatigue. Abstract. In the disclosed embodiments, the upper end of a riser 12 is supported in a catenary riser receptacle 14 positioned in the hull of a platform 10 by a riser hanger 40. ¶¶ 21, 23. The riser hanger 40 can be secured within the receptacle 14 by a latch 46. ¶ 25.

With this understanding of the prior art, it is respectfully submitted that all pending claims are in condition for immediate allowance. Amended independent claim 1 now recites that the bushing is releasably coupled to the keel joint. At no point is the entirety of the invention defined by amended claim 1 disclosed or suggested in the art of record.

As an initial matter, it is believed that Munk '336 is far afield from the present invention.

As understood by the undersigned, Munk '182 does not employ any structure that can be considered to be a bushing wherein the bushing is releasably coupled to the keel joint. In the embodiments depicted in Figures 2 and 4, the support members 34, 72 are not coupled to the member 14. In both cases, the support members have rounded, non-puncturing ends that merely engage the member 14. In the embodiment depicted in Figure 5, the collar 52 is not affixed, *i.e.*, it is not coupled to the riser 14. See, *e.g.*, Col. 4, ll. 46-48. Rather, the collar 92 permits sliding movement of the riser 14 within the collar 92. Thus, it is respectfully submitted that amended independent claim 1 is not anticipated by the prior art of record.

Moreover, it is respectfully submitted that amended independent claim 1 is not obvious in view of the prior art of record. As the Examiner well knows, a recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

Here, there is no suggestion or motivation for a system for guiding a riser wherein a bushing positioned between a keel joint and a keel guide is releasably coupled to the keel joint. In fact, given the nature of the sliding relationship between the collar 92 and the riser 14

described in Munk '182, it is unclear in what manner, if at all, the collar 92 could be releasably coupled to the riser and function for its intended purpose. Suffice it to say that the sliding relationship provided between the collar 92 and the riser 14 is not a releasably coupled connection. In the system in Munk '182, it is unclear why one skilled in the art would be motivated to releasably couple the collar 92 to the riser 14 when the disclosure expressly states that the collar 92 is not affixed to the riser 14, and the sole intent of the device in Munk '182 is to have the riser 14 slide within the collar 92.

It is respectfully submitted that any attempt to assert that the invention defined by amended independent claim 1 would have been obvious to one of ordinary skill in the art necessarily involves an improper use of hindsight using Applicants' disclosure as a roadmap. Thus, it is respectfully submitted that claims 1-8 and 11-13 are in condition for immediate allowance.

It is also respectfully submitted that new independent claim 34 is also allowable over the art of record. Claim 34 recites, among other things, that the bushing is releasably coupled to the keel joint by at least one frangible connection. Such an invention is not even remotely disclosed or suggested in the prior art of record. Again, it is unclear how a frangible connection could be established between the collar 92 and the riser 14 disclosed in Munk '182. What is clear is that there is absolutely no suggestion of providing such a frangible connection between the collar 92 and the riser 14. Accordingly, it is respectfully submitted that new claims 34 and 35 are allowable.

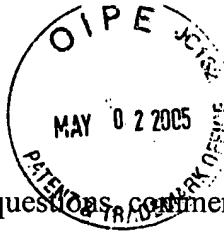
Independent claim 14 has been amended to recite that the landing feature of the keel guide comprises an adjustable locking pin and that the assembly comprises a keel joint assembly that is slidably positioned within the bushing. As thus amended, it is respectfully submitted that

claim 14 is allowable over the prior art of record. Munk '182 does not disclose or suggest that the keel guide may have a landing feature comprised of an adjustable locking pin. As described previously, Munk '182 simply provides a shoulder 104 that engages another shoulder 106. Munk '336 is even further afield from the invention defined by claim 14. In Munk '336, there is no bushing through which a keel joint may be slidingly positioned. The apparatus disclosed in Munk '336 is a fixed system that does not provide for a keel joint to be slidingly positioned within anything that can constitute a bushing. For at least these reasons, it is respectfully submitted that amended independent claim 14, and all claims depending therefrom, are in condition for immediate allowance.

Independent claim 29 has been amended to include the limitations from now-canceled dependent claim 31. More specifically, claim 29 now recites that the bushing comprises a frangible connector for temporarily coupling to a riser assembly. It is believed that this claim is likewise allowable for at least the reasons set forth above with respect to claim 34.

New independent claim 36 has been added to further define Applicants' invention. Support for this claim may be found at, for example, page 7, lines 3-16 and the associated drawings discussed therein. According to claim 36, the keel guide is provided with a side opening that allows the internal diameter of the keel guide to be increased or decreased by actuation of an actuating device. New claim 36 further recites a keel assembly that is slidingly positioned in the bushing. The prior art of record is completely silent with respect to this aspect of the claimed invention. Thus, it is respectfully submitted that new independent claim 36 is likewise in condition for allowance.

For the aforementioned reasons, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney



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at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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